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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/980,523      | 04/29/2002  | Jeannine Choppin     | WOBI AO INS         | 5483             |

466 7590 08/27/2003

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| EXAMINER |
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SALIMI, ALI REZA

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1648

DATE MAILED: 08/27/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/980,523

Applicant(s)  
Choppin et al

Examiner  
A. R. SALMI

Art Unit  
1648



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 30, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) 5 and 7-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 29, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election with traverse of Group I (Claims 1-8, and SEQ ID NO: 6) in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the Office has failed to make a case for imposing lack of unity of invention, since each group is considered linked to form a general inventive concept. In addition, Applicants assert they should not be limited to one sequence. This is not found persuasive because the search for this case is considered to be highly burdensome, the adequate search has to be conducted in both in-house and commercial databases. The information in databases almost double every few months, the office resources are now stretched to the limit, so only the selected sequence will be searched. In addition, as it was stated by the Office the cited evidence i.e. Muller et al proves that the technical feature of Group I does not make a contribution over the prior art. Thus, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 as such the restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

**The claims have been examined only to the extent of selected polypeptide designated as SEQ ID NO: 6. Applicants are requested to amend the claims accordingly.**

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Claims 5, 7, 8, 9-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups, the requirement having been traversed in Paper No. 10. Claims 1-4, and 6 are considered.

**Applicant is reminded to cancel the claims to the non elected claims.**

### *Specification*

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
  - 1. Field of the Invention.

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2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.

- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

***Claim Rejections - 35 USC § 112***

Claims 1-4, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 3, 4 are vague and indefinite for recitation of fragments, the intended metes and bounds of the fragments are not defined. Each and every intended fragment has to be identified by a specific sequence identification number, so one of skill in the art can be appraised of the intended scope of the invention. The claims have been drafted as such that they recite multiple functional assertions. However, the said limitations are meaningless if the exact boundaries of the fragment is not provided. The claims are directed to a product, and not a method of obtaining epitopic region, the product should be clearly presented. The so called E6 protein can be a large

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polypeptide, and presently the claims have set no boundaries as to which E6 protein is intended.

The claims are indefinite for recitation of "HPV", the acronym should follow the full name. Is human papilloma virus (HPV) intended? This affects the dependent claim 6.

Claim 6 is vague, indefinite and unclear for recitation of "corresponds." The claim has been interpreted in view of the specification and it not clear what sequences are encompassed within the limitation of correspond. Corresponding sequences can be calculated by a variety of different methods, whereby the calculated identity between two sequences will be quite different depending on the algorithm used for calculation. Applicant has referred to "correspond", but there are no indication of the utilized algorithm to calculate the sequences.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al (EP 0451-550 A2).

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The disclosure and the claims of the above cited reference meets the broad limitations of the claimed invention (see page 2, lines 30-31, and claim 2). The product disclosed in the above cited reference is identical or so similar that is indistinguishable from the product claimed by the applicants. Applicants are reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products. Hence, the disclosure and claim of the above cited reference anticipates the claimed invention.

Claims 1-4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Frazer et al (WO 98/23635).

The disclosure and the claims of the above cited reference meets the broad limitations of the claimed invention (see the abstract, lines 30-31, and claims 1-2). The product disclosed in the above cited reference is identical or so similar that is indistinguishable from the product claimed by the applicants. The product taught and claimed in the above cited reference also meets the limitation of "correspond." Applicants are reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products. Hence, the disclosure and claim of the above cited reference anticipates the claimed invention.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al (Journal of General Virology, 1990, vol. 71, 2709-2717).

Muller's teaching in the above cited reference meets the broad limitations of the claimed invention (see Table 1). The product disclosed in the above cited reference is identical or so

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similar that is indistinguishable from the product claimed by the applicants. Applicants are reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products. Hence, the disclosure and claim of the above cited reference anticipates the claimed invention.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al (EP 0 523-391A1).

The disclosure and the claims of the above cited reference meets the broad limitations of the claimed invention (see page 7, lines 30, and 40, Table 3, and all claims especially claims 3, 6, 7). The product disclosed in the above cited reference is identical or so similar that is indistinguishable from the product claimed by the applicants. Applicants are reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products. Hence, the disclosure and claim of the above cited reference anticipates the claimed invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-



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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Vitiello et al (U.S. Publication No. 2003/0099634 A1).

The claims and disclosure of the above cited reference meets the broad limitations of the claimed invention (see claims 1, and 8, especially SEQ ID NO: 67). The claim is directed to a product and the above cited art having earlier filing date disclosed the same product that inherently is capable of performing the same task.

Claims 1-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Dillner et al (U.S. Patent No. 5,932,412)

The disclosure and the claims of the above cited reference meets the broad limitations of the claimed invention (see all the claims). The in house sequence search has revealed that the SEQ ID NO: 161, meets the limitations of claim 6 as well.

No claims are allowed.

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*Conclusion*

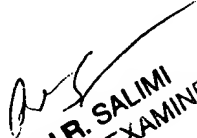
Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (703) 305-7136. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 305-3014, or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A. R. Salimi

8/25/2003

  
ALI R. SALIMI  
PRIMARY EXAMINER